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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,254	12/05/2000	Bradley C. Engel	73352-9003-00	8115
23409	7590	04/25/2005	EXAMINER	
MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202			NAJARIAN, LENA	
			ART UNIT	PAPER NUMBER
			3626	
DATE MAILED: 04/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/730,254	Applicant(s) ENGEL ET AL.	
	Examiner Lena Najarian	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 1/06/05. Claims 1-34 remain pending. Claims 1, 6-8, 14-15, 17, 28, and 33-34 have been amended.

Specification

2. The objection to the abstract is hereby withdrawn due to the amendment filed 1/06/05.

Claim Objections

3. Claim 1 is objected to because of the following informalities: repetitive language in line 4 ("the case statement template"). Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The rejection of claims 6-8, 14, 17-20, and 33-34 under 35 U.S.C. 112, second paragraph, is hereby withdrawn due to the amendment filed 1/06/05.

Claim Rejections - 35 USC § 101

5. The rejection of claims 1-24 and 28-34 under 35 U.S.C. 101 is hereby withdrawn due to the amendment filed 1/06/05.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-2, 6-17, 22-29, and 33-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Henley, for the same reasons given in the previous Office Action. Further reasons appear below.

(A) Claim 1 has been amended to now recite providing, "via a patient terminal," a case statement template and "transmitting" case statement information "specified in the case statement template over a network." The Examiner respectfully submits that Henley discloses at paragraph 87, lines 1-7, a patient interface and a patient submitting a bid via the Internet. As such, it is readily apparent that Henley discloses a patient terminal and the ability to transmit information over a network.

(B) Claims 2, 9-13, 16, 22-27, and 29 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

(C) The amendments to claims 6-8, 14, 17, and 33-34 were apparently made to overcome 112, 2nd paragraph issues set forth in the prior Office Action. However, these changes do not affect the scope and breadth of the claims as originally presented and/or in the manner in which the claims were interpreted by the Examiner when

applying prior art within the previous Office Action. As such, these claims are rejected under the same rationale given in the prior Office Action, and incorporated herein.

(D) Claim 15 has been amended to now recite a healthcare case statement information submission mechanism "configured to provide a case statement template and to transmit case statement information over a network." The Examiner respectfully submits that Henley discloses at Fig. 17A, an online template with a "submit" button. As such, it is readily apparent that Henley discloses a submission mechanism configured to transmit information over a network. Claim 15 also now recites "a case statement engine configured to generate case statements based on the case statement information." The Examiner respectfully submits that Henley discloses at paragraph 120, registration forms (the Examiner interprets "registration forms" to be a form of "case statements") and a posting database where the information from the forms is made available to bidders and providers. As such, it is readily apparent that Henley discloses the ability to generate case statements based on case statement information.

(E) Claim 28 has been amended to now recite "transmitting" case statement information "over a network." The Examiner respectfully submits that Henley discloses at paragraph 87, lines 1-7, a patient submitting a bid via the Internet. As such, it is readily apparent that Henley discloses the ability to transmit information over a network.

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4-5, 19-21, and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henley (US 2002/0065758) as applied to claims 1-2, 15-17, and 28-29 above, and further in view of Tawil (5,519,607), for the same reasons given in the previous Office Action. Further reasons appear below.

(A) Claims 4-5, 19-21, and 31-32 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

10. Claims 3, 18, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henley (US 2002/0065758) in view of Tawil (5,519,607) as applied to claims 1-2, 15-17, and 28-29 above, and further in view of Papageorge (US 6,584,445 B2).

(A) Claims 3, 18, and 30 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

Response to Arguments

11. Applicant's arguments filed 1/06/05 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 1/06/05.

Applicants argue the following:

(1)(a) Applicants argue that Henley does not disclose a “case statement” and does not teach or suggest “preparing a case statement based on the case statement information.”

(1)(b) Applicants argue that the “registration form” cited by the Office is not a “case statement.”

(2) Applicants argue that Henley does not teach or suggest “transmitting the case statement over [a] network to at least one contracting healthcare service provider.”

(3) Applicants argue that Henley does not teach or suggest “transmitting a response from that at least one contracting healthcare service provider, the response including a price, a clinical track record, and service information.”

(4) Applicants argue that Henley does not teach or suggest “a case statement engine configured to generate case statements based on case statement information.”

(5) Applicants argue that Henley does not teach or suggest “a case statement distribution engine to deliver case statements to healthcare service providers.”

(6) Applicants argue that Henley does not teach or suggest “preparing a case statement based on the case statement information.”

(7) Applicants argue that Henley does not teach or suggest “making the case statement available to each contracting healthcare service provider whose profile criteria matches the case statement.”

(8) Applicants argue that Henley does not teach or suggest “receiving a response to the case statement from at least one contracting healthcare service provider, the response including a price, a clinical track record, and non-clinical information.”

(A) As per the first and sixth arguments, applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a case statement that may contain “the reasons for the requested medical care and a description of the chief complaint, the history of the present illness, the past medical history of the patient, a review of systems, the current medications of the patient, allergies, and other pertinent findings”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In addition, it does not appear that Applicant intends to positively and definitely claim these features at page 9 of the 1/06/05 amendment, as evidenced by Applicant's use of non-committal and neutral terminology, namely “**may**”, which suggests that such features are not specifically required. As such, the Examiner respectfully submits that the broadest reasonable interpretation of the term “case statement” would include data such as medical service requests and qualifications for such services, which is precisely disclosed by Henley's “registration form” (note paragraph 120 of Henley).

(B) As per the second argument, the Examiner respectfully submits that Henley discloses at paragraph 84, that the provider must first register to offer services on the

online system (the Examiner interprets "register" to be a form of "contracting"). At paragraph 87, Henley discloses posted data via a patient interface and the ability to negotiate the offering price amongst the patient and the provider. As such, it is readily apparent that Henley's invention teaches transmitting information over a network to at least one contracting healthcare service provider.

(C) As per the third and eighth arguments, the Examiner respectfully submits that Henley discloses at paragraphs 23 and 19, a price, quality of the service (the Examiner interprets "quality" to be a form of "track record"), and service information.

(D) As per the fourth argument, the Examiner respectfully submits that Henley discloses at paragraph 120, registration forms (the Examiner interprets "registration forms" to be a form of "case statements") and a posting database where the information from the forms is made available to bidders and providers. As such, it is readily apparent that Henley discloses the ability to generate case statements based on case statement information.

(E) As per the fifth argument, the Examiner respectfully submits that Henley discloses at paragraph 87, posted data via a patient interface and the ability to negotiate the offering price amongst the patient and the provider. As such, it is readily apparent that Henley discloses the delivering of case statements to healthcare service providers.

(F) As per the seventh argument, the Examiner respectfully submits that Henley discloses at paragraph 104, a "services wanted" bidding database, which is accessible to a plurality of registered providers of medical services. Henley also discloses the authentication of a medical service provider's qualifications (the Examiner interprets "authentication" to be a form of "profile criteria"). As such, it is readily apparent that

Henley discloses making the registration information available to each registered medical provider whose profile criteria matches the registration information.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lena Najarian whose telephone number is (571) 272-7072. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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4-4-05

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